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10/071,266	02/07/2002	Leslie H. Swanson	3161.1000-001	9025

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EXAMINER
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GARG, YOGESH C

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 10/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

*Office Action Summary*

Application No.

10/071,266

Applicant(s)

SWANSON, LESLIE H.

Examiner

Yogesh C. Garg

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 5,6 and 8-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,7,19 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Election/Restrictions***

1. Applicant's election of group I, consisting of claims 1-4, 7 and 19-20, received on 7/25/2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement of species of claims 5-6 and 8-18, the election has been treated as an election without traverse (MPEP § 818.03(a)). Accordingly, claims 5-6 and 8-18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Therefore, currently claims 1-4, 7 and 19-20 are pending for examination.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-4, 7 and 20 are rejected under 35 U.S.C. 101 because the claimed inventions are directed to non-statutory subject matter.

Claims 1-4, 7 and 20 are directed to disembodied data structure claim which are per se not statutory. C.f. In re Wamerdam. The body of the independent claims 1 and 19 are directed to a central database repository for storing product information and this database comprises meta data, schema and an object model system. The database repository mere represents a code stored in a computer readable medium or in a text

form on a paper. The examiner suggests to redraft the claims to include a computer readable medium so that the embedded code/program is executable by a computer or processor. **A claim to a computer readable medium encoded with functional descriptive material that can function with a computer to effect a practical application that results in a useful, concrete and tangible result (i.e. running an assembly line or executing a stock transaction) satisfies Section 101.** See U.S. Patent 5,710,578 to Beauregard etc. i.e., **a set of instructions in combination with a computer system.** C.f. In re Wamerdam - data structure stored in a computer memory, and In re Lowery, 32 USPQ2d 1031 (Fed. Cir. 1994) - data structure in a computer readable medium. Examples of Statutory Functional Descriptive Material are:

(a) A claimed computer-readable medium encoded with a functional data structure – this defines structural and functional relationships between the data structure and the hardware/software components. See Wamerdam.

(b) A claimed computer-readable medium encoded with a computer program - this defines structural and functional relationships between the computer program and the computer itself which allows the program's functionality to be realized provided that a useful, concrete and tangible result is realized. See U.S. Patent 5,710,578 to Beauregard et al.

Data merely stored in a computer readable medium to be read or outputted by a computer without any functional interrelationship, and thus do not impart functionality to the computer, i.e., they are not computer components. Examples of Non-Functional Descriptive Material :Music, Literature, Art, Photographs, Data base per se are directed

to neither a "process" nor a "machine," but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. *Id.* at 1551.

Dependencies of claim 1, that is claims 2-4 and 7 do not overcome the deficiency of claim 1 and therefore they are also rejected based on the same rationale.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3.1. Claims 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 1, the claimed invention, as stated in the preamble, is directed to a system for electronic creation, management and viewing of product information but the body of claim comprises only a central database repository and this was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the database repository as a stand alone for electronic creation, management and viewing product information on a display system. In line with the specification it would be essential to include other elements essentially, such as a plurality of applications, a user interface and a display

system to make use of the central database for electronic creation, management and viewing product information on a display system.

4 The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4.1. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: a plurality of applications, a user interface and a display system to make use of the central database for electronic creation, management and viewing product information on a display system.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5.1. Claims 1-4, 7 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henson (US Patent 6,167,383) in view of Brunner et al. (US Patent 5,550,971), hereinafter referred to Brunner.

Note 1: Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Note 2: The recitation directed to an intelligent product catalog system for electronic creation, management and viewing of product information using a multimedia display system has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In the instant case, the body of the claims 1-4, 7 and 19 are directed to a database which can stand-alone and does not depend on the preamble for its completeness.

5.3. Regarding claims 1-4 & 7. Henson teaches an intelligent product catalog system for electronic creation, management and viewing of product information using a multimedia display system comprising:

a central database repository for storing the product information providing for an unlimited number of product attributes and dynamic reconfiguration of the product information (see at least Fig.1, reference # "24" database), a plurality of applications accessing the central database repository, the applications being automatically adaptive to the dynamic reconfiguration of the product information (see at least Fig.1, " commerce application" which is a bundle of applications including configurator, pricing, validation, etc , which are automatically adaptive to the dynamic reconfiguration of the product information as demonstrated in Fig 3A, 3B, 3C, and 4); a user interface providing display, sorting and filtering of the product information including the unlimited number of product attributes, wherein specific products are selected based upon the product information, the selected products composing a system (see at least Fig 3A, 3B, 3C, and 4 and col.6, lines 18-30).

Henson does not disclose that the central database repository comprises a meta data system, a scheme system and an object model system. However, Brunner teaches that a database comprises a meta data system, a scheme system and an object model system ( see at least col.2, line 47-col.3, line 12). In view of Brunner, it would be obvious to one of an ordinary skilled in the art at the time of the applicant's invention to



have incorporated the features of Brunner in the database disclosed in Henson because doing so would enable Henson's invention to generate a flexible user interface which can dynamically adapt to the underlying schema and various database systems without the need to recode or recompile the software that generates the user interface (see at least Brunner col.2, lines 50-59)

5.4. Regarding claims 19-20 the limitations are closely parallel to the limitations of claim 1 and are therefore, analyzed and rejected on the basis of same rationale used for claim 1.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(i) Srinivasan, V.; and Chang, D.T.; " Object persistence in object-oriented applications"; Vol.36, Number 1, 1997, Application Development discloses the advantages of an Object-Oriented database model.

(ii) US Patent 6,892,185 to Etten et al. , see col.1, lines 5-15, teaches that " *The present invention relates in general to a procurement system. More specifically, the invention relates to a procurement system where a user completes a structured requisition form based predominantly on pre-existing normalized relationships to order an item not available in a catalog database. The form is used to specify the desired item and to selectively create updated normalized relationships for use in identifying the new item so that it and similar items may be placed in the catalog database when free form data is examined using the normalized relationships.* "

(iii) US Patent 6,035,283 to Rofrano teaches a method of providing electronic catalog including creating a data base containing a Sales Agent's information on generic customer product interests and probable buying habits (see at least claim 1, col.5, lines 47-50).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Yogesh C Garg  
Primary Examiner  
Art Unit 3625

YCG  
September 30, 2005